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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,014	06/20/2003	Allen Carl	49386 CON (71995)	7152

21874 7590 09/08/2006

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EXAMINER	
COMSTOCK, DAVID C	

ART UNIT	PAPER NUMBER
3733	

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/601,014	CARL ET AL.	
	Examiner	Art Unit	
	David Comstock	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *34-38,60-63 and 73-100* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *34-38,60-63 and 73-100* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 June 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The corrected abstract of the disclosure is still objected to for the reasons set forth in the previous action. Line 1, "a methods" is not in agreement. Throughout the abstract, if the terms "apparatus" and "apparatuses" are intended to be in the plural form, the terms should be used correctly and consistently. Line 2, "vertebrate" appears to be a typographical error. Line 3, "to forming" is not in agreement and does not make sense. Lines 7 and 8, "...and avoids the associated problems with prior cage or straight rod and screw systems." should be deleted as it improperly sets forth purported advantages of the invention in relation to the prior art.

Appropriate correction is required.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 34-38 and 73-90 are rejected under 35 U.S.C. 101 as clearly claiming the same invention as that set forth within claims 1-61 of prior U.S. Patent No. 6,607,530. This is a double patenting rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 34-38, 60-63 and 73-100 are rejected under 35 U.S.C. 102(b) as being anticipated by Lumb (3,426,364).

Lumb discloses an arcuate implant, e.g. 10, having a uniform radius of curvature and corresponding diameter (see Fig. 1). The implant is configured to support spinal loads. The implant is secured to adjacent vertebrae 26. The implant has guiding means 48 at its ends. The implant includes a spacer element 12. A hole is formed in the vertebrae to accommodate a portion 50 of the device. The hole is at a midpoint between the endplates of each vertebra. A rotary cutting tool, i.e. a drill, is used to form the holes that accommodate portions of the device.

Response to Arguments

Applicant's arguments filed 22 June 2006 have been fully considered but they are not persuasive insofar as they remain rejected above.

With regard to claims 34-38 and 73-90 and in response to applicant's argument that U.S. patent no. 6,607,530 does not set forth substantially the same invention, it is noted that the characterization of the invention set forth by the preamble (i.e. whether a "kit," "system," "apparatus," etc.), has not been given patentable weight. It appears that the substance of the inventions described in the conflicting claims is substantially the same.

There is nothing in the claims that precludes an interpretation of the limitations therein to admit of the arcuate implant comprising element 50. In addition, the drill, as well as the screws themselves, in fact, cut a channel or aperture into the vertebrae, and the screws can be characterized as part of an implant.

In response to applicant's argument that the device of Lumb is not the same as that of applicant's, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The noted claims also do not set forth a use with a femur; thus, applicant is arguing limitations not found in the claims.

It is also noted that, absent an interpretation giving undue weight to an intended use, several of the claims (e.g., at least independent claims 34, 36 and 38) do not

require anything more than an arcuate member. It is noted that applicant can facilitate a complete search by including, at the time of filing, claims varying from the broadest *to which they believe they are entitled* to the most detailed that they would be willing to accept. See MPEP 904.03. It should be mentioned that the subject matter of at least, for example, independent claims 34, 36 and 38 is so astonishingly broad as to raise the question of why it is being presented at all. It is noted that these claims essentially set forth nothing more than *an arcuate member* (that is capable of being used in any way in conjunction with a spine).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Comstock

EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER